



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,564	09/22/2000	Julie T. Dawe	10003368-1	2998

7590 03/10/2004
Hewlett-Packard Company
Intellectual Property Administration
P O Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LEE, CHEUKFAN

ART UNIT PAPER NUMBER

2622

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,564

Applicant(s)

DAWE, JULIE T.

Examiner

Cheukfan Lee

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1,9,19-23 and 29 is/are rejected.
- 7) ☒ Claim(s) 2, 4-7, 10-15, and 24-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2622

1. Claims 1, 2, 4-17, and 19-29 are pending. Claims 21-29 are newly added.

Claims 1, 8, 16, 19, and 21 are independent.

2. Claims 1, 9 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10 and 20, respectively, of copending application Serial No. 09/696,719.

The rejection stands since Applicant has not addressed the merits of the current rejection but chose to address them once it is non-provisional in nature. Please refer to the previous Office action mailed Dec. 9, 2003.

3. Applicant's arguments filed Dec. 9, 2003 with respect to claims 19 and 20, and new claims 21-23 and 29 have been fully considered but they are not persuasive. The rejection stands and is slightly modified and repeated below. See rejection and response to Applicant's arguments below.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. (U.S. Patent No. 6,043,866).

Regarding claim 19, Kawai et al. discloses an original carrier used with an original scanner (col. 3, line 59- col. 9, line 20). The carrier (Figs. 1, 2 and 4-20) has an opaque sheet (1) and a transparent sheet (2). An original to be scanned is placed between the sheets (1 and 2). The carrier has a layout template (within an area of 1) (Figs. 1, 2, 5-8, 12-14, and 17-20) that defines a layout area accommodating at least one object that is to be contained in the produced copy. The carrier is convertible between a layout mode and a duplication mode. In the layout mode, the layout area is observable by a user so that the user may observe an arrangement of the object(s) within the layout area. In the duplication mode, the carrier with the arranged original(s) or object(s) are scanned to produce a copy of the arrangement. Kawai et al. Does not explicitly disclose making a greeting card using the produced copy of the arranged original(s) or object(s). Since the original or object being reproduced includes a postcard with a photograph, i.e., not just text (Figs. 5-8 and 18), one of ordinary skill in the art would have realized that a greeting card is produced when such a produced copy is folded. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a greeting card using the produced copy of Kawai et al. by folding the produced copy of the original(s) or object(s) to make variety of uses of the scanner or duplication apparatus.

With regard to Applicant's remarks on pages 9-10 (amendment filed Dec. 9, 2003), Applicant argues that Kawai fails to teach or suggest a method for making a greeting card that meets the limitations of claim 19 because Kawai solves different

problems that the claimed invention. However, in the claim 19 invention, except the term "greeting card", nothing recited in the claim makes the claimed invention as a whole patentably distinct from Kawai et al. Although Kawai et al. does not directly suggest making a "greeting card", one of ordinary skill in the art would have realized the fact that a copy or product produced by using the method of Kawai et al. is easily made into a greeting card by, for example, folding the produced copy. It is common knowledge to one of ordinary skill in the art that a printed copy, be it printed out after arranging images on a computer display either by operator manipulation of the images and/or text on display, or printed out from a document scanner which has the capability to arrange or rearrange the scanned in images or a combination of images and text, once folded, become a greeting card.

Referring back to claim 19, a "greeting card" is not defined to be something different from the folded copy discussed above. With the disclosure of Kawai et al. and the common knowledge of one of ordinary skill in the art, using the produced copy of Kawai et al. to provide a greeting card would have been obvious. Therefore, the claimed invention is not patentably distinct from the obvious method of Kawai et al.

Regarding claim 20, see discussion for claim 19 above with respect to folding the copy to make a greeting card.

New claim 21 is also met by the obvious apparatus of Kawai et al. discussed above. Note in Fig. 1 and 2 of Kawai et al., that the cover (2) pivotally mounted to the

Art Unit: 2622

lower sheet (1) (layout template defining one or at least one layout area) reads on the claimed cover member pivoted between a first position and a second position (closed position). In its opened position, the cover (2) exposes the one or at least one layout area when it is in its open position, and in its closed position, the cover (2) secures the one or at least one object placed in between the sheets (1 and 2).

Regarding claim 22, the cover member (upper sheet 2) is provided with at least one opening, provided with elements (2a, 2b, 2c, etc.) (Figs. 6-8, col. 5, lines 22-55).

Regarding claim 23, the cover (upper sheet 2) comprises a transparent material.

Regarding claim 29, Kawai et al. further discloses a guideline (tacky 31e in Fig. 20) provided on the lower or opaque sheet (1) (layout template), the guideline defining one layout area (col. 9, lines 10-16).

6. Claims 24-28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 2, 4-7 and 10-15 are objected to as being dependent upon the rejected base claim 1, which is provisionally rejected under the judicially doctrine of obviousness-type double patenting, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 16 and 17 are allowed.

Art Unit: 2622

9. The allowable subject matter of now canceled claim 3 has been incorporated into independent claim 1. However, claim 1 and its dependent claim 9 are not in condition for allowance because of the provisional, obviousness-type double patenting rejection addressed above.

10. The following is an examiner's statement of reasons for allowance:

Claim 24 would be allowable over Kawai et al. because Kawai et al. does not disclose a rigid and transparent cover member (2). The cover sheet (2) is made of flexible material.

Claim 25 would be allowable because the lower sheet (opaque sheet 1) (layout template) of Kawai et al. does not define any opening therein, the opening defining the at least one layout area.

Claim 26 would be allowable because Kawai et al. does not disclose a backing member as claimed in addition to the cover member (2) and the layout template (1).

Claims 27 and 28 depend upon claim 26.

Independent claims 8 and 16 are allowed. Claim 8 has been rewritten in independent form. Claim 8 was indicated allowable if rewritten in independent form. Claim 16 was indicated allowed. See previous Office action mailed Sept. 9, 2003.

Claim 17 depends upon claim 16.

Claim 8 is allowable because Kawai et al. does not disclose a backing member as claimed, in addition to the transparent cover member (2) and layout template (lower sheet 1).

Claim 16 is allowable because Kawai et al. does not disclose an aperture grille operatably associated with the backing member that define a layout area which accommodates at least one object that is to be contained in a greeting card, the aperture grille including at least one opening therein, in combination with other limitations of claim 16. The template (lower sheet 1) of Kawai et al. is not an aperture grille.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2622

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (703) 305-4867. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
March 5, 2004



Cheukfan Lee